

### **REMARKS**

This Application has been carefully reviewed in light of the Office Action mailed December 29, 2004. Claims 1-22 were pending in the Application. Claims 1-22 remain pending in the Application. Applicants respectfully request reconsideration and favorable action in this case.

In the Office Action, the following actions were taken or matters were raised:

### **SECTION 102 REJECTIONS**

Claims 1-12 and 14-17 were rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,185,900 issued to Rabindran et al. (hereinafter "*Rabindran*"). Applicants respectfully traverse this rejection.

Of the rejected claims, Claims 1, 9 and 14 are independent. Applicants respectfully submit that *Rabindran* does not anticipate independent Claims 1, 9 and 14. For example, independent Claim 1 is directed toward "a template for a scanning system" (emphasis added), independent Claim 9 is directed toward a "transparent media adapter for a scanning system (emphasis added), and independent Claim 14 is directed toward a "method of scanning an image on a transparent media" (emphasis added). In contrast, *Rabindran* is directed toward a roll film reader for microfiche such that light is shown through the microfiche to project an image on the microfiche onto a screen (*Rabindran*, column 2, lines 55-68, column 3, lines 1-20). Accordingly, Applicants respectfully submit that the *Rabindran* reference does not perform any scanning operation or function and, therefore, for at least this reason, *Rabindran* does not anticipate independent Claims 1, 9 or 14.

Claims 2-8, 10-12 and 15-17 that depend respectively from independent Claims 1, 9 and 14 are also not anticipated by *Rabindran* at least because they incorporate the limitations of respective Claims 1, 9 and 14 and, also, they add additional elements that further distinguish *Rabindran*. Therefore, Applicants respectfully request that the rejection of Claims 2-8, 10-12 and 15-17 be withdrawn.

### **SECTION 103 REJECTIONS**

Claims 13 and 18-22 were rejected under 35 U.S.C. 103(a) as being unpatentable over *Rabindran* and further in view of U.S. Patent No. 3,677,635 issued to Van Auken et al. (hereinafter "*Van Auken*"). Applicants respectfully traverse this rejection.

Of the remaining rejected claims, Claim 18 is independent, and Claim 13 depends from independent Claim 9. For at least the reasons discussed above, Claim 9 is in condition for allowance. Therefore, for at least this reason, Claim 13 that depends from independent Claim 9 is also in condition for allowance.

Further, the Manual of Patent Examining Procedure makes clear that to establish a *prima facie* case of obviousness, three basic criteria must be met:

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

M.P.E.P. § 2143 (citing *In re Vaeck*, 947 F.2d 488, (Fed. Cir. 1991)). Further, according to M.P.E.P. § 2143.01:

[T]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.

M.P.E.P. § 2143.01 (citing *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990)).

Applicants respectfully submit that the Examiner has not met the burden of establishing a *prima facie* case of obviousness in the present Application. For example, in the Office Action, the Examiner admits that *Rabindran* does not disclose a reflective scanner, comprising a platen, a lamp, an optic system and one or more photosensitive devices (Office

action, page 5). However, the Examiner states that *Van Auken* purportedly teaches these claim limitations in the context of a copying machine and that:

[I]t would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine *Van Auken's* invention with that of *Rabindran* for reading/scanning and copying of transmissive and reflective documents. and; a transparent media adapter comprising a switch disposed on a housing of the transparent media adapter; the transparent media adapter operable to illuminate a transparent media and to transmit a signal to a computer coupled to the scanner system upon actuation of the switch; and a template comprising an actuation device for actuating the switch, the computer directing the scanner system to execute a scan routine upon reception of the signal.

(Office Action, pages 5 and 6). The Examiner appears to state nothing more than that it would have been obvious to combine reference teachings followed by a recitation of Applicants' Claim 18. Accordingly, the Examiner's statement merely begs the question and offers none of the required showings in support of its apparent conclusion; reliance on such a statement to reject the claims under 35 U.S.C. § 103 is clearly impermissible under the M.P.E.P and the courts. Therefore, for at least this reason, Applicants respectfully request that the rejection of Claims 13 and 18-22 be withdrawn.

Moreover, Applicants respectfully submit that there is no suggestion or motivation to combine reference teachings as proposed by the Examiner, nor any reasonable expectation of success. For example, the Examiner appears to suggest that it would have been obvious to incorporate a platen, a lamp, an optic system and one or more photosensitive devices into the microfiche reader of *Rabindran*. Applicants respectfully submit that there is no motivation or suggestion to combine these elements in the *Rabindran* device at least because the *Rabindran* device is used for projecting light through a microfiche to view the microfiche image on a screen; there would be no point in adding additional and unnecessary equipment to the *Rabindran* device for the *Rabindran* device to function as a microfiche reader. Additionally, if this is the basis for the Examiner's proposed combination of reference teachings, which Applicants submit would be improper, the Examiner offers no basis or reasoning as to how the *Rabindran* device would be operable for its intended purpose (to project light through a microfiche to view the microfiche image on a screen) based on the

proposed combination. Applicants respectfully remind the Examiner that it is well settled that the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicants' disclosure. Further, it is well settled that the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. Moreover, not only must there be a suggestion to combine the functional or operational aspects of the combined references, but also the prior art is required to suggest both the combination of elements and the structure resulting from the combination. Applicants respectfully submit that the Examiner clearly has not met the burden of establishing a *prima facie* case of obviousness at least because the prior art does not suggest the proposed combination or references or a reasonable expectation of success thereof, nor has the Examiner provided any reasoning or basis as to the structure resulting from the proposed combination. Accordingly, Applicants respectfully submit that the rejection of Claims 13 and 18-22 based on the *Rabindran* and *Van Auken* references is improper and should be withdrawn.

**CONCLUSION**

Applicants have made an earnest attempt to place this case in condition for immediate allowance. For the foregoing reasons and for other reasons clearly apparent, Applicant respectfully requests reconsideration and full allowance of all pending claims.

No fee is believed due with this Response. If, however, Applicant has overlooked the need for any fee due with this Response, the Commissioner is hereby authorized to charge any fees or credit any overpayment associated with this Response to Deposit Account No. 08-2025 of Hewlett-Packard Company.

Respectfully submitted,

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